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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,616	02/21/2002	Andreas Wieck	101769-141/tesa AG 1527-C	9569
27384	7590	01/24/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			NORDMEYER, PATRICIA L	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/081,616	<b>Applicant(s)</b> WIECK ET AL.	
	<b>Examiner</b> Patricia L. Nordmeyer	<b>Art Unit</b> 1772	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 18, 2004 has been entered.

### ***Specification***

2. The disclosure is objected to because of the following informalities: There is no support in the specification for the presence or lack thereof "carbon black" or "non-carbon black".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 2, 8 – 11 and 16 – 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 2, 8 – 11 and 16 – 18 contain the term “non-carbon black color layer” when referring to the protective material made with a polymer backing sheet. There is no support for this above claimed limitation in the specification. Carbon black is discussed on page 1, line 31 to page 2, line 5, but the discussion appears to be directed towards how a polyester film is effected by the presence carbon black and not directed towards the claimed invention.

Claims 3 – 7 and 12 – 15 are also rejected under first paragraph of 35 U.S.C. 112 due to their dependency on the above rejected claims.

Clarification/correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greuse et al. (USPN 5,250,336) in view of Higgins (USPN 5,932,352).

Greuse et al. disclose a protective material with punched shaped parts (Figs. 3-4) as well as a method of using the protective material (see Abstract) wherein a double sided adhesive tape is placed on top of the protective material (Fig. 1, #14) from which punch shaped parts are

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punched out by a kiss-cut punching tool ("die-cut" - Col. 4, lines 18-19) wherein the protective material comprises a colored polymer backing sheet having a top and a bottom face (note that the Examiner has defined the combination of layers #16 and #18 (the backing layer and release layer) as the polymer backing sheet - see Fig. 1). The backing sheet comprises a backing layer which itself may comprise colorants (Col. 7, lines 52-56) and further comprises an anti-adhesive dyed silicone layer along the top face of the backing sheet (Fig. 1, #16; Col. 3, lines 59-62; Col. 4, lines 1-2; Col. 7, line 64 to Col. 8, line 4) that is in contrast with the color of the backing layer (Col. 7, lines 56-62), the anti-adhesive coating being positioned on the same side of the backing layer as the adhesive tape (see Fig. 1). The color layer is applied over the full area of the backing layer (see Fig. 1; Col. 4, line 49-56). While the preferred colorant material is carbon black (Column 7, lines 64 - 66), Greuse et al. disclose that the colorant could be any variation of a coloration where the coloration does not migrate into either the blacking paper or the pressure sensitive material (Column 7, line 67 to Column 8, line 2). Although Greuse et al. teach the use of a backing layer, Greuse et al. fail to explicitly teach that the backing layer is one of polyester, polystyrene, polyamide, or polyimide and also fail to explicitly teach the thickness of the backing layer.

Higgins, however, teach the use of a polymer backing sheet for a release film wherein the backing sheet may be formed from polyester (Col. 2, lines 16-18). The backing sheet, depending on the intended application, may range in thickness from 5 to 350 micrometers (Col. 8, lines 43-48). Higgins teaches the use of a polyester polymeric backing sheet in a release liner for the purpose of providing a substrate with improved processability and improved suppression of

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silicone debris production (Col. 1, lines 35-56). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Greuse et al. and Higgins since each of the aforementioned references are analogous insofar as being directed at silicone release liners and are both concerned with minimizing silicone debris production.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Greuse et al. to include a polyester backing sheet as taught by Higgins in order to provide a substrate with improved processability and improved suppression of silicone debris production.

Regarding the claims limitations of the non-carbon black color layer is applied to the polymer backing at from about 4 to 8 g/m<sup>2</sup> or 5 to 7 g/m<sup>2</sup> in claims 16 and 17, Greuse et al. teach that the coating density may be modified depending on the desired color of the end product (Col. 5, lines 7-24; Col. 5, lines 31-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the dyed silicone layer such that it fell within the Applicant's claimed range in order to attain a desired color for the end product. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the coating density of the silicone release layer such that it falls within the Applicant's claimed range, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

***Response to Arguments***

7. Applicant's arguments with respect to claims 1 – 18 have been considered but are moot in view of the new ground(s) of rejection. However, since the same references are being applied in the above rejection, the arguments will be responded to below.

In response to Applicant's argument that Greuse et al. fails disclose a colorant other than carbon black colorant, which is not suitable for the claimed invention, Greuse et al. does disclose that the preferred embodiment is a carbon black colorant (Column 7, lines 64 – 66); however, Greuse et al. also disclose another colorant of any variation may be used as long as it does not migrate into either the backing paper or the pressure sensitive adhesive (Column 7, line 66 to column 8, line 2). It would have been obvious to one of ordinary skill in the art at the time the applicant's invention to choose the desired colorant, which meets the limitations of a lack of migration into either the backing paper or the pressure sensitive adhesive, through routine experimentation and in the absence of unexpected results.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*Harold Y. Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

*1/24/05*